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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,962	06/22/2001	Hassan Jomaa	JOMAA-5(PCT)	9943
30593	7590	01/12/2005	EXAMINER	
HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 8910 RESTON, VA 20195			COPPINS, JANET L	
			ART UNIT	PAPER NUMBER
			1626	

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/868,962	<b>Applicant(s)</b> JOMAA, HASSAN	
	<b>Examiner</b> Janet L. Coppins	<b>Art Unit</b> 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on 20 September 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 13-24 is/are pending in the application.  
     4a) Of the above claim(s) 20-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24 is/are rejected.
- 7) ☒ Claim(s) 13-19, 23 and 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

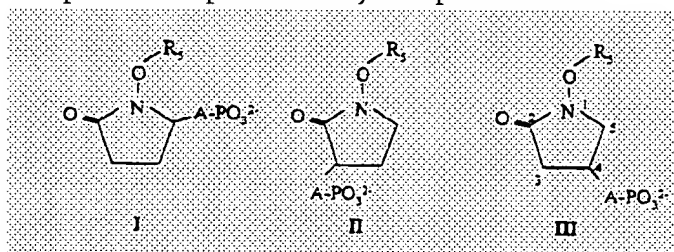
Claims 13-24 pending in the instant application.

***Information Disclosure Statement***

1. Applicants' Information Disclosure Statement (IDS), filed June 22, 2001, has been considered by the Examiner. Please refer to Applicants' copy of the PTO-1449 form submitted herewith.

***Response to Restriction Requirement***

2. Applicants' election **without** traverse of Group 1, claims 13-19, 23, and 24 (all claims in part) drawn to compounds of Formula I and their pharmaceutical compositions wherein the compound is represented by compounds I-III:



In the response filed September 20, 2004, is acknowledged. Accordingly, claims 20-22 withdrawn from further consideration under 37 CFR 1.142(b) as directed to non-elected inventions.

***Status of the claims***

5. Claims 13-24 are pending in the application. As a result of the election and the corresponding scope of the invention identified supra, claims 20-22 and the remaining subject matter of claims 13-19, 23, and 24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to non-elected inventions. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require

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separate search considerations. In addition, a reference that anticipates one group would not render obvious the other groups.

6. In order to advance prosecution, the Examiner recommends canceling the withdrawn claims and subject matter when responding to this Office Action, i.e. claims 20-22 as well as the non-elected subject matter from the remaining claims.

### *Claim Objections*

7. Claims 13-19, 23, and 24 objected to as containing non-elected subject matter.

8. Claims 1-6, 8-10, 12-19, and 21-24 objected to because of the use of the variable "P" in the structure of formula (1a). "P" is also the designated abbreviation for phosphorous within the I.U.P.A.C. nomenclature system, and its presence as a variable is confusing in the instant claims.

### *Claim Rejections - 35 USC § 112*

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claim 24 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 24 is directed to a pharmaceutical preparation that, "...contains another pharmaceutical[ly] active substance," which is vague because it is unclear which active substance Applicant is intending to claim. Clarification is requested.

### *Conclusion*

11. In conclusion, claims 13-24 are pending, claims 20-22 are withdrawn, claim 24 is rejected, and claims 13-19, 23, and 24 are objected to.

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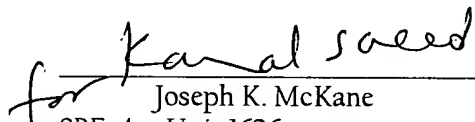
*Telephone Inquiry*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Coppins whose telephone number is 571.272.0680. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571.272.0699. The fax phone number for the organization where this application or proceeding is assigned is 571.273.8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Janet L. Coppins  
January 10, 2005

  
\_\_\_\_\_  
Joseph K. McKane  
SPE, Art Unit 1626